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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/910,115      08/13/97      BAYCHAR

BAY-310

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EXAMINER

JUSKA, C

ART UNIT

PAPER NUMBER

1771

20

DATE MAILED: 10/23/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
08/910,115

Applicant(s)  
Baychar

Examiner  
Cheryl Juska

Art Unit  
1771



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Jul 17, 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-13, 16, and 20-44 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 26-28, 32, and 38 is/are allowed.
- 6) ☒ Claim(s) 1-13, 16, 20-25, 29-31, 33-37, and 39-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 20) ☐ Other:

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## **DETAILED ACTION**

### ***Request for Continued Examination***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 17, 2001 has been entered.

### ***Response to Amendment***

2. Amendment D, submitted as Paper No. 19 on July 17, 2001, has been entered. Claims 14, 15, and 17-19 have been cancelled, while claim 20 has been amended as requested. New claims 25-44 have been added. Applicant has also requested the amendment of claim 17. However, said amendment has not been entered, since claim 17 was just cancelled as requested.

3. Amendment D is sufficient to withdraw the 112, 2nd rejections set forth in sections 6-10 of the last Office Action.

### ***Specification***

4. The use of the trademarks have been noted in this application. They should be capitalized wherever they appear and be accompanied by the generic terminology. Said rejection is

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maintained from the last Office Action, section 3(b). Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 33, 34, 39, 40, and 42-44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claims 33, 39, and 43 are indefinite for the use of a trademark, Kevlar, in the claim.

*v/d (10-11-08)*  
Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 USC 112, 2nd paragraph. See *Ex parte Simpson*, 218 USPQ 1020. The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves.

8. Claims 34, 40, and 44 are indefinite because of the phrase "cotton blend is one of a group consisting of denim and chino fabrics." The terms 'denim' and 'chino' describe fabric weaves (i.e., twill) and are not necessarily limited to cotton blend fabrics.

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9. Claims 42 and 43 are indefinite for a lack of antecedent basis for the phrase “outer moisture transfer material.” Claim 41, from which claims 42 and 43 depend, merely recites an “outer fabric layer.”

***Claim Rejections - 35 USC § 102***

10. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

11. Claims 1-4, 8-10, and 16 stand rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 4,338,366 issued to Evans et al.

Applicant has not amended said claims in an attempt to overcome said rejection.

Applicant merely traverses said rejection by arguing that Evans teaches an outer layer having liquid retention characteristics rather than moisture transport properties and that Evans does not teach a breathable membrane (Amendment D, page 7, 4th paragraph). In response, it is reiterated that the outer wicking layers of the Evans invention are comprised of cloth-like webs “have a combination of thickness, porosity, and liquid retention characteristics which when taken together promote *rapid transport of primary drops of liquid* (col. 5, lines 18-25). Thus, it is asserted that the outer layers of Evans anticipate Applicant’s inner and outer moisture transfer materials. With respect to the breathable membrane, it is reiterated that the meltblown nonwoven material of Evans can be broadly interpreted as a “breathable membrane.” Therefore, the rejection of claims 1-4, 8-10, and 16 is hereby maintained.

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12. Claims 1-4, 6, 8-10, 12, and 16 stand rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 4,338,371 issued to Dawn et al.

Applicant has not amended said claims in an attempt to overcome said rejection.

Applicant merely traverses said rejection by arguing that the absorbent mass of Dawn suited for disposable diapers does not function in the same manner as Applicant's moisture transfer apparel (Amendment D, page 8, 1st paragraph). In response, it is reiterated that the present limitation to an "apparel" is not given patentable weight because the recitation is a preamble recitation to the intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Therefore, claims 1-4, 6, 8-10, 12, and 16 stand rejected as being anticipated by the cited Dawn patent.

13. Claim 20 stands rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 5,637,389 issued to Colvin et al.

The amendment to claim 20 was to overcome the 112, 2nd rejection rather than the prior art rejection. Applicant merely traverses said rejection by asserting that the encapsulation process of Colvin does not teach that it is performed for waterproofing (Amendment D, page 8, 2nd paragraph). In response, it is noted that the feature upon which Applicant relies (i.e.,

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waterproofing) is not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Therefore, the rejection of claim 20 is maintained.

***Claim Rejections - 35 USC § 103***

14. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

15. Claims 7 and 13 stand rejected under 35 U.S.C. 103(a) as being unpatentable over the cited Dawn patent in view of US Patent 5,269,862 issued to Nakajima et al.

Since Applicant does not traverse said rejection, it is maintained for the reasons of record.

16. Claims 5, 11, and 21-24 stand rejected under 35 U.S.C. 103(a) as being unpatentable over the cited Evans and/or Dawn patents in view of the cited Colvin patent.

Since Applicant does not traverse said rejection, it is maintained for the reasons of record.

***New Prior Art Rejections--102***

17. New claims 35 and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by the cited Evans or Dawn patents.

Claims 35 and 36 include a recitation to a cellular, elastomeric composite which includes a hydrophilic, open cell foam backed by a nonwoven sheet. Cancelled claim 14 also included the

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limitation of an elastomeric composite foam with a nonwoven material. As noted in the previous Office Actions, Evans and Dawn anticipated claim 14. It is now asserted that the hydrophilic open cell limitations are also anticipated by the cited Evans and Dawn patents. Specifically, it is asserted that both the foams of Evans and Dawn are taught to be absorbent foams. Since, a hydrophobic foam would not provide absorbency and a closed cell foam would not provide the required porosity, the foams of Evans and Dawn must inherently be hydrophilic and open cell in order to provide the desired absorbency. Therefore, claims 35 and 36 are anticipated by the cited Evans and Dawn patents.

#### ***New Prior Art Rejections--103***

18. New claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over the cited Evans and/or Dawn patents, as applied to claim 8 above, in view of the cited Colvin patent.

New claims 29-31, 37, and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over the cited Evans and/or Dawn patents in view of the cited Colvin patent.

The limitations of claims 25, 29-31, 37, and 41 have been previously addressed. Thus, said claims are rejected based upon arguments analogous to those already presented.

#### ***Allowable Subject Matter***

19. Claims 26-28 are allowed. Said claims are allowable because the prior art does not teach or fairly suggest a composite liner material for use in apparel comprising (a) an inner moisture



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transfer material, (b) an open cell foam material, and (c) an outer layer of cotton fabric treated by encapsulation.

20. Claims 32 and 38 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art does not teach or fairly suggest the presently claimed open cell foam with reversible thermal properties and an outer moisture transfer material of an encapsulated cotton fabric.

### *Conclusion*

21. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Cheryl Juska whose telephone number is (703) 305-4472. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Terrel Morris, can be reached at (703) 308-2414. The official fax number for this TC 1700 is (703) 872-9310 and, for After Final communications, (703) 872-9311.



CHERYL A. JUSKA  
PRIMARY EXAMINER

cj

October 12, 2001